



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2013-0013]

After Final Consideration Pilot Program 2.0

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice

SUMMARY: The United States Patent and Trademark Office (USPTO) has modified the After Final Consideration Pilot Program (AFCP) to create the After Final Consideration Pilot Program 2.0 (AFCP 2.0). Applicants who wish to participate in AFCP 2.0 must file a request to have a response after final rejection (which the examiner may have sufficient basis not to consider under current practice) considered by the examiner without reopening prosecution. The response after final rejection must include an amendment to at least one independent claim. The examiner will be allotted a set amount of time under AFCP 2.0 to consider the response. If the examiner's consideration of a proper AFCP 2.0 request and response does not result in a determination that all pending claims are in condition for allowance, the examiner will request an interview with the applicant to discuss the response. There are thus three main differences between

AFCP and AFCP 2.0: an applicant must request to participate in AFCP 2.0; a response after final rejection under AFCP 2.0 must include an amendment to at least one independent claim; and the examiner will request an interview with the applicant to discuss a response, if the response did not result in a determination that all pending claims are in condition for allowance. The goal of AFCP 2.0 is to reduce pendency by reducing the number of Requests for Continued Examination (RCE) and encouraging increased collaboration between the applicant and the examiner to effectively advance the prosecution of the application. There is no additional fee required to request consideration of an amendment after final rejection under AFCP 2.0, but any necessary existing fee, e.g., the fee for an extension of time, must still be paid.

DATES: Effective Date: May 19, 2013.

Duration: AFCP 2.0 will run from its effective date until September 30, 2013. A request to consider an amendment after final rejection under AFCP 2.0 must be filed on or before September 30, 2013. The USPTO may extend AFCP 2.0 (with or without modifications) depending on feedback from the participants and the effectiveness of the pilot program.

FOR FURTHER INFORMATION CONTACT: Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7728, or by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: As outlined herein, AFCP 2.0 involves responses filed after a final rejection pursuant to 37 CFR 1.116. Under current practice, examiners have sufficient basis not to consider many responses filed after a final rejection, including responses that would require further search and/or consideration. See, e.g., sections 714.12 through 714.13 of the Manual of Patent Examining Procedure (8th ed. 2001) (Rev. 9, August 2012) (MPEP). AFCP 2.0 allots a limited amount of time for examiners to consider responses after final rejection that include an amendment to at least one independent claim and require further search and/or consideration. Examiners will also use the time allotted to them under AFCP 2.0 to conduct an interview to discuss the response, for those responses that do not place the application in condition for allowance. AFCP 2.0 will help inform the USPTO as to whether authorization of the limited amount of time will reduce the number of RCEs. AFCP 2.0 replaces AFCP, which terminates on May 18, 2013.

A. AFCP 2.0 Requirements

In order to be eligible to participate in AFCP 2.0, an application must contain an outstanding final rejection and be (i) an original utility, plant, or design nonprovisional application filed under 35 U.S.C. 111(a), or (ii) an international application that has entered the national stage in compliance with 35 U.S.C. 371(c). A continuing application (e.g., a continuation or divisional application) is filed under 35 U.S.C. 111(a) and is thus eligible to participate in AFCP 2.0. Reissue applications and reexamination proceedings are not eligible to participate in AFCP 2.0.

A request for an examiner to consider an amendment after final rejection under AFCP 2.0 must include the following items: (1) a transmittal form, such as form PTO/SB/434, that identifies the submission as an AFCP 2.0 submission and requests consideration under AFCP 2.0; (2) a response under 37 CFR 1.116, including an amendment to at least one independent claim that does not broaden the scope of the independent claim in any aspect; (3) a statement that the applicant is willing and available to participate in any interview initiated by the examiner concerning the accompanying response; and (4) any necessary fees.

Only one request for consideration under AFCP 2.0 may be filed in response to an outstanding final rejection. Second or subsequent requests for consideration under AFCP 2.0 filed in response to the same outstanding final rejection will be processed consistent with current practice concerning responses after final rejection under 37 CFR 1.116. In addition, all papers associated with this pilot program must be filed via the USPTO's Electronic Filing System-Web (EFS-Web).

1. Transmittal Form

AFCP 2.0 requires applicants to specifically request consideration under the program. The USPTO has included this requirement in an effort to focus the program on applications that are more likely to benefit from the program. The requirement to request consideration should also improve the data generated on the effectiveness of the program. Applicants are advised to use form PTO/SB/434, which is available at

<http://www.uspto.gov/forms/index.jsp>, to request consideration under AFCP 2.0. Use of this form will also help the Office to quickly identify AFCP 2.0 submissions and facilitate timely processing of such submissions. The Office of Management and Budget (OMB) has determined that, under 5 C.F.R 1320.3(h), form PTO/SB/434 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

2. Amendment

A submission under AFCP 2.0 must include a response filed under 37 C.F.R. 1.116. The 37 CFR 1.116 response must include an amendment to at least one independent claim. The amendment may not broaden the scope of the independent claim in any aspect. For the purposes of AFCP 2.0, the analysis of whether an amendment to an independent claim impermissibly broadens the scope of the claim will be analogous to the guidance set forth in section 1412.03 of the MPEP for determining whether a reissue claim has been broadened.

3. Interview statement

A submission under AFCP 2.0 must include a statement by the applicant that they are willing and available to participate in any interview initiated by the examiner concerning the response filed with the AFCP submission. Form PTO/SB/434 includes the required interview statement.

4. Any Necessary Fees

A submission under AFCP 2.0 must also include any fees that would be necessary, consistent with current practice concerning an after final response under 37 CFR 1.116. For example, an AFCP 2.0 submission that is filed more than three months after the mailing of a final rejection must include the appropriate fee for an extension of time under 37 CFR 1.136(a).

B. Processing of AFCP 2.0 Submissions

Upon receipt of the AFCP 2.0 submission, the examiner will review the submission to ensure that the transmittal form, amendment, interview statement, and any necessary fees are provided. If the submission is incomplete, then the examiner will process the submission consistent with current practice concerning responses after final rejection under 37 CFR 1.116.

Upon verifying that the AFCP 2.0 submission complies with the requirements of the program, the examiner will perform an initial review of the amendment. During the initial review, the examiner will determine if additional search and/or consideration would be required to determine whether the amendment would distinguish over the prior art, and if such search and/or consideration would be possible within the time allotted to them under the AFCP 2.0 program. If additional search and/or consideration would be required but could not be completed within the allotted time, the examiner will process the submission consistent with current practice concerning responses after final rejection under 37 CFR 1.116, e.g., by mailing an advisory action.

If the examiner determines that the amendment does not necessitate additional search and/or consideration, or if the examiner determines that additional search and/or consideration is required and could be completed within the allotted time, then the examiner will consider whether the amendment places the application in condition for allowance (after completing the additional search and/or consideration, if required). If the examiner determines that the amendment places the application in condition for allowance, then the examiner will enter the amendment and mail a notice of allowance. If the examiner determines that the amendment does not appear to place the application in condition for allowance, then the examiner will contact the applicant to schedule an interview to discuss the amendment.

The interview will be conducted by the examiner, and if the examiner does not have negotiation authority, a primary examiner and/or supervisory patent examiner will also participate. Following the interview, the examiner will proceed with an appropriate response to the submission after final rejection according to current practice. If the applicant declines the interview, or is unable to schedule the interview within ten (10) calendar days from the date the examiner first contacts the applicant, then the examiner

may proceed with an appropriate response to the submission after final rejection according to current practice.

Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

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